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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,214	02/08/2001	Stephen J. Boies	1963-5005	6637

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/779,214

Applicant(s)

BOIES ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-26 are presented for examination.

**Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is non-statutory, the claims define instructions for execution on a computer i.e. a computer code per se. A computer program/code m per se does not define any structural and functional interrelationships that permit the computer program's functionality to be realized. It is for these reasons that the above claims are deemed to be non-statutory.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 24 recites the limitation "the computer executable code" in line 1. There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 15, 19-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Teper et al (5,815,665 hereinafter Teper).

With respect to claims 1, 15, 19-21, 23 and 25, Teper teaches a method for providing a consumer service on a network service provider (Figure 1). Registering users with the aggregation service (col. 5, lines 26-30); granting the registered user access to the world wide web through the aggregation service (col. 5, lines 33-37); replacing the registered user's individual identity with the aggregation service identity as the user browses World Wide Web sites (col. 5, lines 33-37 and col. 6, lines 5-10).

With respect to claims 2, 24 and 26, Teper further teaches receiving transaction information for at least one registered user (Figure 2, 82); intercepting an electronic merchandise order placed by the registered user with a merchant through an electronic network (Figure 2, 84); charging the registered user for the order and executing the order with the merchant on the registered user's behalf so that the aggregation service's identity is charged by the merchant for the order (Figure 2, 88 and col. 11, lines 46-59); and storing information regarding each purchase in a database (col. 8, lines 63 to col. 9, lines 1-8).

With respect to claim 22, Teper further recites that the information regarding each purchase is stored in a database (col. 8, lines 63 to col. 9, lines 1-8).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper.

Claims 3-4, 16 further recites that the aggregation service ships the purchased product to the user once the purchased product is received. Official notice is taken that it is old and well known for the customers to assign a third party to receive his/her merchandise and for the third party to ship or send the item to the purchaser. For example, a customer can assign a person to receive his/her merchandise when not at home and then that third person sends the merchandise to the purchaser. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the aggregation service ships the purchased product to the user once the purchased product is received in order to achieve the above mentioned advantage.

Claims 4-8 further recite the aggregation service collecting coupons for the purchaser based on the purchases made. Official notice is taken that it is old and well known for the customers to assign a third party to receive his/her bonus/discounts. For example, a customer can assign a person to receive his discounts/coupons and

manage his discounts in order to provide convenience to the customers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the aggregation service collecting the coupons for the purchases made in order to achieve the above mentioned advantage.

Claims 9-10 further recite that the aggregation service obtains financial benefits, the benefit being a volume discount offered to the users based on the aggregate purchase volume at the merchant's site. Official notice is taken that is old and well known in marketing to offer a fee to third parties for referring customers to the merchants, the fee can be in a form of discounts for the volume purchases made. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the aggregation service obtaining financial benefits, the benefit being a volume discount offered to the users based on the aggregate purchase volume at the merchant's site in order to obtain the above mentioned advantage.

Claims 11-14 further recite several well known financial benefits such as upgrade on the method of shipping, half price on the second purchased items, etc. that can be offered to the users. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included several well known financial benefits such as upgrade on the method of shipping, half price on the second purchased items, etc. in order to motivate the users to make purchases.

Claim 17 further recites that the registered user physical address is only decodable by the shipping company. Official notice is taken that it is old and well known in encryption for certain entities to be able to decode certain data in order to provide

Art Unit: 3622

data security. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included that the registered user physical address is only decodable by the shipping company in order to achieve the above mentioned advantage.


Claim 18 further recites permitting the user to specify the maximum price of items that the user is interested in purchasing. Official notice is taken that it is old and well known in buyers driven system for buyers to specify the maximum price that they are willing to pay for the items and for the sellers to bid for the customers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included permitting the user to specify the maximum price of items that the user is interested in purchasing in order for the purchases to control the price on the items.

**Point of contact**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
5/24/04